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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,235	08/05/2003	Peter Bernhardt	1-24671	6403

4859 7590 12/17/2004

MACMILLAN SOBANSKI & TODD, LLC  
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TOLEDO, OH 43604-1619

EXAMINER

GARCIA, ERNESTO

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 12/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/634,235

Applicant(s)

BERNHARDT, PETER

Examiner

Ernesto Garcia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 August 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12/16/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the sealing surface 30 being longer than the holding surface 20 (claim 1) must be shown or the feature(s) canceled from the claim(s). Since holding surface 20 transitions into a tapered surface (unlabeled) how can applicant say that Figure 1 shows the sealing surface 30 being longer than the holding surface 20 when the tapered surface is what is beyond the holding surface. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended". If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled

"Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

Claims 1, 3 and 5 are objected to because of the following informalities:  
regarding claim 1, "them" in line 2 needs to be defined;  
regarding claim 3, "its" in line 2 needs to be defined; and,  
regarding claim 5, "it" in line 2 needs to be defined, and "said" in line 3 should be --a-- as "a component has not been previously recited. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 3, it is unclear from what feature of the invention is the "contact surface" as recited in line 1. Is the contact surface from the housing, the ball stud, the sealing bellows, or the component?

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless—

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by the German patent, DE-2,945,234 (see marked-up attachment).

Regarding claim 1, the German patent '234 discloses, in Figure 1, a ball joint comprising a housing **1**, a ball stud **11**, and a sealing bellows **2**. The sealing bellows **2** lies against the housing **1** and the ball stud **11**. The ball stud **11** has a holding surface **A4**. A sealing surface **A5** of the sealing bellows **2** lies against the holding surface **A4**. The sealing surface **A5** is longer than the holding surface **A4** along a longitudinal axis of the ball stud **11**.

Regarding claim 2, the holding surface **A4** and the sealing surface **A5** are cylindrical.

Regarding claim 3, contact surface **A7** is provided on the ball stud **11** and adjoins the holding surface **A4** on a side facing away from the housing **1**. Applicant is reminded that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Therefore, the ball stud **11** can be adapted to be mounted to a component.

Regarding claim 4, the sealing bellows **2** is provided with a metal ring **10** urging the sealing surface **A5** against the holding surface **A4**.

Regarding claim 5, the sealing bellows **2** is dimensioned such that the sealing bellows **2** cannot slip off from the holding surface **A4**.

Claims 1 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Smith et al., 3,216,754 (see marked-up attachment).

Regarding claim 1, Smith et al. disclose, in Figure 4, a ball joint comprising a housing **20**, a ball stud **12**, and a sealing bellows **80**. The sealing bellows **80** lies against the housing **20** and the ball stud **12**. The ball stud **12** has a holding surface **16**. A sealing surface **A5** of the sealing bellows **80** lies against the holding surface **16**. The

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sealing surface **A5** is longer than the holding surface **16** along a longitudinal axis of the ball stud **12**.

Regarding claim 5, the sealing bellows **80** is dimensioned such that the sealing bellows **80** cannot slip off from the holding surface **16**.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al., 3,216,754, in view of German patent, DE-2,945,234.

Regarding claim 4, Smith et al., as discussed above, fails to provide a metal ring to the sealing bellows **80** urging the sealing surface **A5** against the holding surface **16**. The German patent teaches a sealing bellows 2 provided with a metal ring 10 urging a sealing surface against a holding surface to seal the sealing bellows to a ball stud. Therefore, as taught by the German patent, it would have been obvious to one of

ordinary skill in the art at the time the invention was made to provide the sealing bellows with a metal ring to seal the bellows to the ball stud.

### ***Conclusion***

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure. European patent, EP1052418, German patent, DE-19,834,678, Modat, 6,488,436 and Gottschald show a similar ball joint.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernesto Garcia whose telephone number is 703-308-8606. The examiner can normally be reached from 9:30-6:00. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 703-308-2686. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for



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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).



E.G.

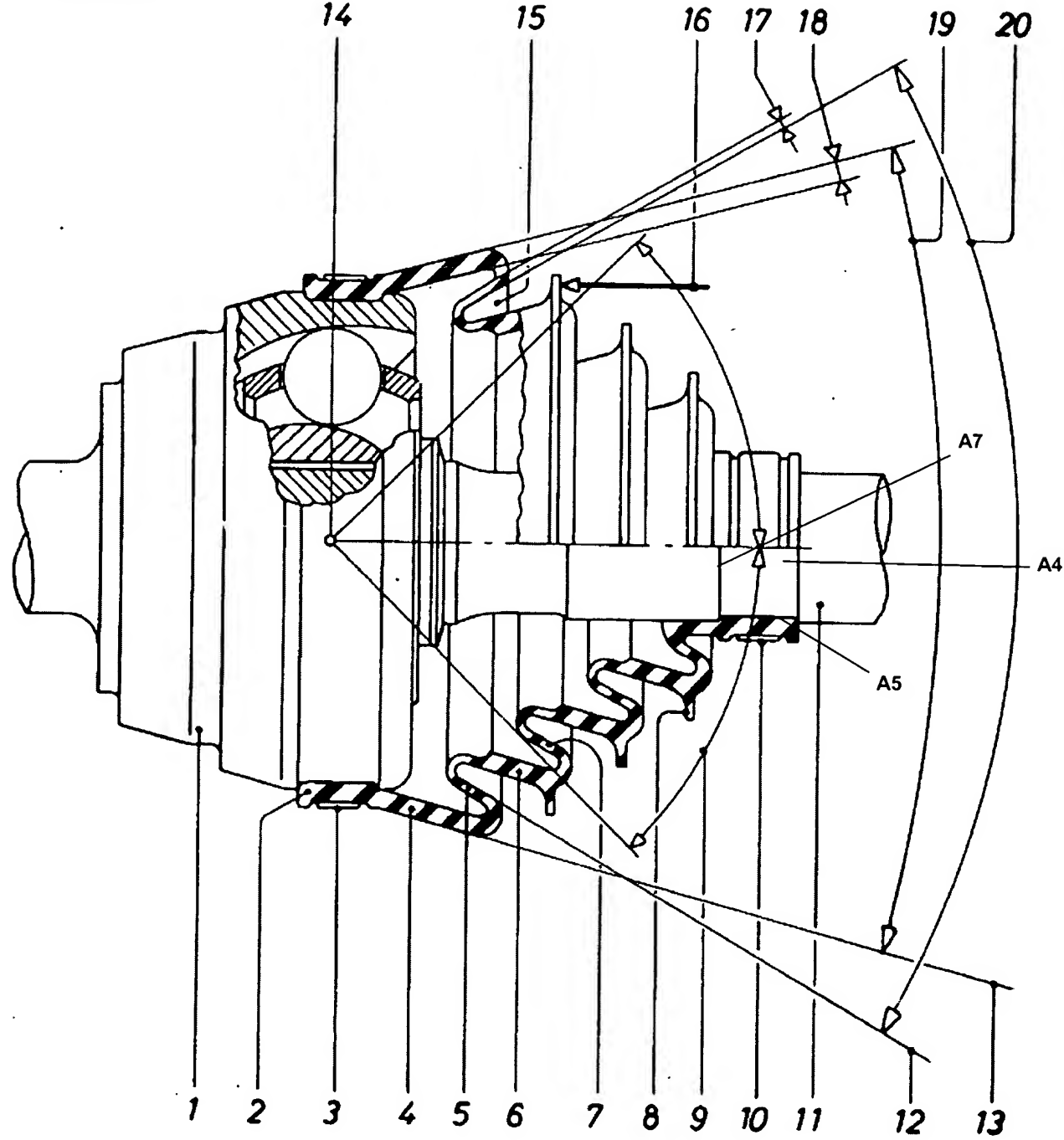
December 9, 2004



DANIEL P. STODOLA  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600

Attachments: one marked-up page of German patent, DE-2,945,234; and,  
one marked-up page of Smith et al., 3,216,754.

DE-2,945,234



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(Smith et al.) 3,216,754

